

VEDDERPRICE

VEDDER, PRICE, KAUFMAN & KAMMHOLZ, P.C.  
222 NORTH LASALLE STREET  
CHICAGO, ILLINOIS 60601  
312-609-7500  
FACSIMILE: 312-609-5005

RECEIVED  
CENTRAL FAX CENTER

SEP 08 2005

## Facsimile

OFFICES IN CHICAGO, NEW YORK CITY AND ROSELAND, NEW JERSEY

If you have any problems with this transmittal,  
please call 312 609-5001.  
Our Fax Number is 312-609-5005.

**Confidentiality Note**  
This message is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivery of the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone at 312-609-5001, and return this original message to us at the above address via the U.S. Postal Service. Thank you.

Fax Operator:

Please deliver the following page(s) to:

Page 1

**Name:** Commissioner for Patents  
United States Patent and Trademark  
Office  
Mail Stop Patent Ext.

**Fax No.:** 571-273-8300**From:** Mark A. Dalla Valle**Confirmation No.:** 571-272-4200**Date:** September 8, 2005**Sender's Ext.:** 7620**Client No.:** 11461.00.0076 (P04793)**Total Pages:** 13**Time Received by Fax Dept.:**

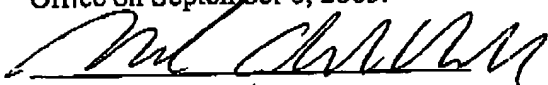
2005 SEP 8 AM 10:39

Special instructions to receiving operator:

## Message:

U.S. Patent No. 6,917,608, Issued July 12, 2005  
Docket No. 11461.00.0076 (P04793)

I hereby certify that this correspondence; Petition To Correct PTA (6 pages), PAIR pages (2 pages), and copies of auto-reply facsimile transmission and corresponding POA and Statement Under 37 CFR filed on 12/13/04 are being facsimile transmitted to the United States Patent and Trademark Office on September 8, 2005.

  
Mark A. Dalla Valle  
Reg. No. 34,147

RECEIVED  
OIPE/IAP

SEP 12 2005

SEP 08 2005

U.S. Patent No. 6,917,608 B1

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

David Weigand

Group Art Unit: 2661

Patent No.: 6,917,608

Examiner: David R. Vincent

Application No.: 09/746,903

Confirmation No.: 1918

Issued: July 12, 2005

PETITION TO CORRECT

Filed: December 22, 2000

PATENT TERM ADJUSTMENT

For: MICROSEQUENCER

MICROCODE BANK

SWITCHED ARCHITECTURE

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Via Facsimile 571-273-8300

09/12/2005 HDEMESS2 00000069 220259 6917608

01 FC:1455 200.00 DA

Sir:

This Petition, submitted pursuant to 37 C.F.R. § 1.705(d), seeks correction of the patent term adjustment of 754 days indicated in U.S. Patent No. 6,917,608 B1 ("the '608 Patent"). It is respectfully requested that Assignee be afforded a patent term adjustment of 874 days.

In accordance with Rule 1.705(d):

1. The notice of allowance indicates a patent term adjustment of 819 days and was subsequently revised prior to issuance.
2. This request for reconsideration of the patent term adjustment is respectfully filed within two months of the date the '608 Patent issued.
3. Assignee submits herewith the fee (\$200) set forth in 37 C.F.R.

CHICAGO/#1412768.1

1

U.S. Patent No. 6,917,608 B1

PATENT

- § 1.18(e) as required by 37 C.F.R. §§ 1.705(d) and 1.705(b)(1).
4. Assignee submits herewith a statement of the facts as required by 37 C.F.R. §§ 1.705(d) and 1.705(b)(2) including statements indicating that:
- a) the correct patent term adjustment is 874 days, the basis for the adjustment under § 1.702, the relevant dates as specified in §§ 1.703(a)-(e) and the adjustment as specified in § 1.703(f);
  - b) the patent is not subject to a terminal disclaimer; and
  - c) the circumstances during prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.
5. This request for reconsideration does not raise issues that were raised or could have been raised in an application for patent term adjustment under 37 C.F.R. § 1.705(b) because the patent term adjustment indicated in the notice of allowance was proper at the time it was mailed.

**REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(d)**A. Statement of the Facts

Assignee respectfully submits that the correct patent term adjustment is 874 days and requests correction of the erroneous term printed in the '608 Patent. In support, Assignee has included in this petition a copy of: (1) the "Patent Term Adjustment History" printed from PAIR ("PTA History") and (2) the auto-reply facsimile transmission and corresponding Power of Attorney and Statement Under 37 C.F.R. § 3.73(b) filed on December 13, 2004 ("Power of Attorney").

*i. §§ 1.702-1.703 Delays Attributable to the Patent Office*

Assignee respectfully submits two bases for adjustment under Patent Rule 1.702. The first basis is the failure of the Office to "[m]ail at least one of a notification under 35 U.S.C. [§] 132 or a notice of allowance under 353 U.S.C. [§]

U.S. Patent No. 6,917,608 B1

PATENT

151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. [§] 111(a) . . . .” 37 C.F.R. § 1.702(a)(1) (2004). As indicated by the attached PTA History, Assignee filed the application (which later matured into the ‘608 Patent) under 35 U.S.C. § 111(a) on December 22, 2000. More than fourteen months later, the Patent Office (“Office”) first responded to Assignee’s December 22, 2000 filing in a May 24, 2004 Office Action.

As a result, the first period of adjustment under Rule 1.702(a) is the “number of days . . . in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. [§] 111(a) . . . and ending on the date of mailing of either an action under 35 U.S.C. [§] 132, or a notice of allowance under 35 U.S.C. [§] 151, whichever occurs first.” 37 C.F.R. § 1.703(a)(1). February 23, 2001 is day after the date that is fourteen months after the application was filed. The first Office Action, the first response from the Office, was mailed on May 24, 2004. Therefore, the proper period of adjustment is the sum of the days beginning on February 23, 2001 and ending on May 24, 2004. The first period of adjustment under 37 C.F.R. § 1.702 is 822 days.

The second basis for adjustment is the failure of the Office to “[i]ssue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. [§] 151 and all outstanding requirements were satisfied.” 37 C.F.R. § 1.702(a)(4). As indicated by the attached PTA History, Assignee paid the issue fee on January 18, 2005. However, the ‘608 Patent did not issue until July 12, 2005, more than four months after payment of the issue fee.

As a result, the second period of adjustment under Rule 1.702(a) is the “number of days . . . beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.” 37 C.F.R. § 1.703(a)(6). May 19, 2005 is the day after the date that is four months after the date the issue fee was paid. July 17, 2005 is the day the ‘608 Patent issued. Therefore, the second period of adjustment under 37 C.F.R. § 1.702 is 55 days.

U.S. Patent No. 6,917,608 B1

PATENT

Because there are no overlapping grounds for adjustment under 37 C.F.R. § 1.703, Patent Rule 1.703(f) is not applicable. The sum of the first and second period of adjustment is 877 days.

*ii. § 1.704 Delays Attributable to the Assignee*

Assignee notes one event during prosecution of the '608 Patent that may have delayed processing of the application as set forth in § 1.704. Assignee further notes that the PTA History attributes an additional delay of 120 days to Assignee. It is for this 120 day penalty that the present petition is submitted under 37 C.F.R. § 1.705(d).

Addressing the first event, the PTA History provides a three day delay in accordance with Rule 1.704(c)(8) for the filing of an information disclosure statement ("IDS") on August 19, 2004. As indicated on the PTA History, the IDS was submitted after the August 16, 2004 filing of Assignee's response to the Office's first Office Action.

Because Assignee filed the IDS after its response to the first Office Action, 37 C.F.R. § 1.704(c)(8) requires a period of adjustment of the 877 delay set forth in § 1.703 measured "by the number of days . . . beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed." August 17, 2004 is the day after the date the initial reply (i.e., Assignee's response) was filed. August 19, 2004 is the day the supplemental reply/other paper (i.e., the IDS) was filed. Therefore the period of adjustment under Rule 1.704 is 3 days.

With respect to the 120 day delay contested hereinbelow, Assignee respectfully submits and the attached auto-reply facsimile transmission confirms, that the attached Power of Attorney (and corresponding statement under 37 C.F.R. § 3.73(b)) was filed on December 13, 2004, after the notice of allowance. However, the PTA History lists the submission as a "Miscellaneous Incoming Letter." Because of this improper label, the Office appears to have relied on 37 C.F.R. § 1.704(c)(10) in penalizing Assignee an additional 120 days (i.e., four

U.S. Patent No. 6,917,608 B1

PATENT

months) for the "submission of an amendment under § 1.312 or other paper after a notice of allowance."

Because of the aforementioned, the patent term adjustment was reduced from 877 to 754 days.

*iii. Terminal Disclaimer Status & Non-applicability of § 1.705(b)*

Assignee respectfully submits that no terminal disclaimer was filed in the present case. Additionally, Assignee submits that this request for reconsideration could not have been raised under 37 C.F.R. § 1.705(b). Rule 1.705(b) applies only to a "request for reconsideration of the patent term adjustment indicated in the notice of allowance . . . [and] must be filed no later than the payment of the issue fee. . . ." 37 C.F.R. § 1.705(b). Because the Notice of Allowance indicated the proper patent term adjustment of 819 days as of the date it was mailed and because the alleged 120 day delay occurred after the Notice of Allowance, Assignee had no access to Rule 1.705(b).

B. Request for Reconsideration under § 1.705(d)

Assignee respectfully submits that the proper patent term adjustment is 874 days. Citing official Office literature, the submission of a power of attorney after a notice of allowance does not delay prosecution, unlike a traditional amendment filed under Rule 1.312. Therefore, Assignee should not receive a reduced period of adjustment under Rule 1.704 because the Office improperly labeled and categorized the Power of Attorney statement as a "Miscellaneous Incoming Letter."

As noted, official Office literature supports this equitable interpretation of Patent Rule 1.704(c)(10). As indicated in the Official Gazette published June 26, 2001, the Office specifically noted that not all papers "filed after a notice of allowance cause substantial interference and delay in the patent issue process." Nicholas P. Godici, *Clarification of 37 C.F.R. 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, OG 26 June 2001 ¶ 2 (2001), <http://www.uspto.gov/web/offices/com/sol/og/2001/week26/patcfr1.htm>. To

U.S. Patent No. 6,917,608 B1

PATENT

illustrate this policy, the Office stated that certain papers do not delay examination and may not be used as a basis under § 1.704(c)(10) to reduce the patent term adjustment. "The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, [and] (3) Power to Inspect . . . ." *Id.* at ¶ 3 (emphasis added).

Because official Office literature supports Assignee's contention that Power of Attorney statements do not delay prosecution and because the Office improperly characterized its Power of Attorney statement as a "Miscellaneous Incoming Letter" thereby invoking application of Rule 1.704 in contrast to official Office policy, Assignee respectfully requests reconsideration of the patent term adjustment. Specifically, Assignee requests that the patent term adjustment properly account for the 374 days of administrative delay by the Office.

Please charge the cost of the fee (\$200) to the PTO deposit account of Vedder, Price, Kaufman & Kammholz, P.C., account number 22-0259.

Respectfully submitted,

VEDDER, PRICE, KAUFMAN &amp; KAMMHOLZ, P.C.

Date: September 8, 2005

By: Mark A. Dalla Valle  
Reg. No. 34,147

Attorney for Assignee  
222 N. LaSalle St.  
Chicago, IL 60601  
Telephone: 312-609-7500  
Facsimile: 312-609-5005  
Customer No. 23418  
Atty. Docket: P04793  
(11461.00.0076)

CHICAGO/#1412768.1

6



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [oBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)**PATENT APPLICATION INFORMATION RETRIEVAL****Patent Term Adjustment (PTA) for publication number: 09/746,903**

			Days
Filing or 371(c) Date:	12-22-2000	USPTO Delay (PTO):	877
Issue Date of Patent:	07-12-2005	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	123
Post-Issue Petitions (days):	+0	Total PTA:	754
USPTO Adjustment (days):	+0	Explanation of Calculations	

## Search Options

Image File Wrapper
File History
Maintenance Fees - Retrieve fees to pay
Maintenance Fees - View payment windows
Maintenance Statement - View 04 year payment window
Maintenance Statement - View 08 year payment window
Maintenance Statement - View 12 year payment window
Published Documents

Maintenance Fees Available: Mon-Fri 5:30 AM to Midnight, Sat-Sun-Hol. 7:30 AM to 8:00 PM E.T.

Patent Term Adjustment History			
Date	Contents Description	PTO (days)	APPL (days)
06-22-2005	PTA 36 Months		
07-12-2005	Patent Issue Date Used In PTA Calculation	55	
06-08-2005	Receipt into Pubs	↑	
06-08-2005	Dispatch to FDC	↑	
06-08-2005	Application Is Considered Ready for Issue	↑	
01-18-2005	Issue Fee Payment Verified	↑	
12-13-2004	Miscellaneous Incoming Letter		120
06-02-2005	Receipt into Pubs		
04-11-2005	Workflow - Query Request - Finish		
03-16-2005	Workflow - Query Request - Begin		
01-18-2005	Issue Fee Payment Received		
11-22-2004	Workflow - File Sent to Contractor		
11-05-2004	Mail Notice of Allowance		
11-02-2004	Issue Revision Completed		
11-02-2004	Case Docketed to Examiner in GAU		
11-02-2004	Notice of Allowance Data Verification Completed		
10-16-2004	IFW TSS Processing by Tech Center Complete		
08-19-2004	Reference capture on IDS		
08-19-2004	Information Disclosure Statement (IDS) Filed		3
10-16-2004	Date Forwarded to Examiner		↑
08-16-2004	Response after Non-Final Action		

BEST AVAILABLE COPY



			↑
05-24-2004	Mail Non-Final Rejection	822	
05-20-2004	Non-Final Rejection	↑	
04-28-2004	Miscellaneous Incoming Letter	↑	
04-19-2004	Case Docketed to Examiner in GAU	↑	
03-11-2002	Case Docketed to Examiner in GAU	↑	
08-14-2001	Change in Power of Attorney (May Include Associate POA)	↑	
08-14-2001	Correspondence Address Change	↑	
08-14-2001	Change in Power of Attorney (May Include Associate POA)	↑	
06-22-2001	Case Docketed to Examiner in GAU	↑	
06-04-2001	Application Dispatched from OIPE	↑	
02-15-2001	Application Is Now Complete	↑	
02-06-2001	Correspondence Address Change	↑	
01-12-2001	IFW Scan & PACR Auto Security Review	↑	
12-22-2000	Initial Exam Team nn	↑	

## Auto-Reply Facsimile Transmission



TO:

Fax Sender at 312 609 5005

Fax Information

Date Received:

12/13/2004 4:21:09 PM [Eastern Standard Time]

Total Pages:

3 (including cover page)

**ADVISORY:** This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received  
Cover  
Page

=====

12/13/2004 10:51 FAX 312 609 5005		VEDDER PRICE KAUFMAN		0001	
<b>VEDDERPRICE</b>		VEDDER, PRICE, KAUFMAN & KAUFMAN, P.C. 222 NORTH LA SALLE STREET CHICAGO, ILLINOIS 60601 312-609-7800 FAX(TEL): 312 609 5005			
<b>Facsimile</b>		BY FAX TO 00000000, 00000000 FAX 312 609 5005, 00000000			
<p>If you have any questions with this document, please call 877-835-5275. Our Fax Number is 312-609-5005.</p>		<p>Unauthorized use of this document is prohibited. This document is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee of an addressee for delivery to the addressee in the intended capacity, you are hereby notified that any disclosure, reproduction or copying of the contents of this message is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone at 312-609-5005, and where appropriate, delete it from your system. Thank you.</p>			
Please deliver the following page(s) to:		Page 1			
Name: U.S. Patent and Trademark Office		Fax No.: 703-872-9308			
From: Mark A. Della Valle		Confirmation No.: 312-609-5005			
Date: December 13, 2004		Sender's Ext.: 7620			
Client No.: 11461.00.0076		Total Pages: 3			
		Time Received by Fax Dept.: 2004 DEC 13 PM 2:50			
<p>Message: U.S. Patent Application No. 09/746,905, filed December 22, 2000, Docket No. 11461.00.0076</p> <p>I hereby certify that this correspondence, Power of Attorney (PTO/SB/91) and Statement Under 37 CFR (PTO/SB/96) are being facsimile transmitted to the United States Patent and Trademark Office on December 13, 2004.</p> <p><i>Mark A. Della Valle</i> Mark A. Della Valle Reg. No. 34,147</p>					
<p>PAGE 13 * RCV'D AT 12/13/2004 12:50 PM [Eastern Standard Time] * SVR:USPTO-EFXXF-6/27 * DNIS:2738300 * CSID:3126095001 * DURATION (mm-ss):03-20</p>					

\*\*\*\*\*  
 \*\*\* TX REPORT \*\*\*  
 \*\*\*\*\*

TRANSMISSION OK

TX/RX NO 1847  
 CONNECTION TEL 11461000076#917038729306  
 CONNECTION ID  
 ST. TIME 12/13 15:21  
 USAGE T 01'04  
 PGS. SENT 3  
 RESULT OK

**DOCKETED**

CLIENT NSC  
 FILE NO. 11461.00.0076  
 DUE DATE  
 BY 2-3 DATE 2/15/04

**VEDDERPRICE**

VEDDER, PRICE, KAUFMAN & KAMMHOFF, P.C.  
 222 NORTH LASALLE STREET  
 CHICAGO, ILLINOIS 60601  
 312-609-7500  
 FACSIMILE: 312-609-5005

**Facsimile**

OFFICES IN CHICAGO, NEW YORK CITY AND ROSELAND, NEW JERSEY

If you have any problems with this transmittal,  
 please call 312 609-5001.  
 Our Fax Number is 312-609-5005.

**Confidentiality Note**  
 This message is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivery of the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone at 312-609-5001, and return this original message to us at the above address via the U.S. Postal Service. Thank you.

Fax Operator:

Please deliver the following page(s) to:

Page 1

Name: U.S. Patent and Trademark Office  
 Firm:  
 From: Mark A. Dalla Valle  
 Date: December 13, 2004  
 Client No.: 11461.00.0076

Fax No.: 703-872-9306  
 Confirmation No.: 312-609-5005  
 Sender's Ext.: 7620  
 Total Pages: 3  
 Time Received by Fax Dept.: 2604 DEC 13 PM 2:5

**Message:**

U.S. Patent Application No. 09/746,903, filed December 22, 2000, Docket No. 11461.00.0076

I hereby certify that this correspondence; Power of Attorney (PTO/SB/81) and Statement Under 37 CFR (PTO/SB/96) are being facsimile transmitted to the United States Patent and Trademark Office on December 13, 2004.